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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,776	04/07/1999	LILI KANG	0100.9900270	6690

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EXAMINER	
PIZIALI, JEFFREY J	

ART UNIT	PAPER NUMBER
2673	27

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/287,776	Applicant(s) KANG ET AL.	
	Examiner Jeff Piziali	Art Unit 2673	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: *1-8*.

   Claim(s) objected to: _____.

   Claim(s) rejected: *9-22*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

J.P.

Continuation of 2. NOTE: The proposed amendment filed 7 January 2004 (Paper No. 26), if entered, would newly add the limitation, "to programmably switch video data from the video scaler into one of at least first and second video overlay generators" to independent claim 1; the limitation, "a programmable switch, operatively coupled to the video scaler and to at least said first video overlay generator and said second video overlay generator, to programmably switch video data from the video scaler to at least one of: said first video overlay generator and said second video overlay generator" to both independent claim 9; as well as the limitation, "to facilitate selective display of overlay data and video on each one of a plurality of display devices" to independent claim 15. Such limitations, if incorporated into claim language, would dramatically alter the scope of the present invention, requiring additional search and consideration.

Applicants' arguments filed 7 January 2004 (Paper No. 26) have been fully considered but they are not persuasive. The applicants assert, "agreement was reached during the telephone interview that such an amendment [i.e. to programmably switch video data from the video scaler into one of at least first and second video overlay generators] to claim 1 would not render the claim unpatentable" (see 1st paragraph, page 8). The examiner respectfully disagrees with this assertion. No statement was made by either examiner regarding the patentability of this newly submitted claim limitation. Although said claim limitation does upon initial inspection appear to be supported by the specification of the present application (i.e. in all probability, not new matter), the sudden inclusion of this limitation into claim language would alter inventive scope, requiring additional search and consideration of existing prior art before patentability of the instant invention could therefore be adequately determined.

Additionally, the applicants contend, "the claims have been reworded to expressly recite that the overlay generators are each capable of being coupled to multiple display devices" (see 2nd paragraph, page 8). Again, the examiner respectfully disagrees. A careful inspection of the proposed amendment reveals that independent claim 9 would (even in its newly worded state) continue to merely recite, "each of the video overlay generators outputs overlay information for a corresponding display device." As such, this claim limitation would continue to be read upon by the existing, cited (see the Final Office Action mailed 12 August 2003 -- Paper No. 21) prior art of Ranganathan (US 5,764,201).

By such reasoning, nonentry of the proposed amendment is deemed proper and necessary at this time. In addition, the rejection of claims 9-22 is deemed proper, necessary, and thereby maintained at this time.

Amare Mengistu
Primary Examiner